

## REMARKS

The Application has been reviewed in light of the Office Action mailed December 22, 2005. At the time of the Office Action, Claims 44-63 were pending. Claims 1-43 were previously cancelled by Applicants. Claims 44-63 stand rejected. Applicants amend Claim 44, and respectfully request reconsideration and favorable action in this case.

### Claim Objections

Claim 44 was objected to for containing lack of antecedent basis. Applicants respectfully submit an amended version of the claim with the correction.

### Rejections under 35 U.S.C. §103

Claims 44-47 were rejected under 35 U.S.C. §103(a) as being unpatentable over *Upgrading & Fixing PCs for Dummies: 4th Edition* by Andy Rathbone (“Rathbone”) in view of *More Businesses Buying PCs Online* by April Jacobs (“Jacobs”), and further in view of *Computer Hardware Maintenance: An IS/IT Manager’s Guide* by Stephen C. Rood (“Rood”).

Claim 48 was rejected under 35 U.S.C. §103(a) as being unpatentable over Rathbone, Jacobs, and Rood, as with Claim 44 above, and in further view of *Integrating Old PCs Back Into Society* by Karen Kaplan (“Kaplan”).

Claim 49 was rejected under 35 U.S.C. §103(a) as being unpatentable over Rathbone, Jacobs, Rood and Kaplan, as with Claim 48 above, and further in view of *A PC Buyer’s Primer* by Edward N. Siguel (“Siguel”).

Claims 50 and 57 were rejected under 35 U.S.C. §103(a) as being unpatentable over Rathbone, Jacobs, Rood, and Kaplan, as with Claim 48 above, and further in view of U.S. Patent No. 6,012,045 issued to Nizan Barzilai et al. (“Barzilai et al.”).

Claim 51 was rejected under 35 U.S.C. §103(a) as being unpatentable over Rathbone, Jacobs, and Rood, as with Claim 44 above, and further in view of *Getting Personal: A Growing*

*Number of Computer-Buyers Are Opting For Made-to-Order Machines* by Preston Sparks (“Sparks”).

Claims 52-56 were rejected under 35 U.S.C. §103(a) as being unpatentable over Rathbone, Jacobs, and Rood, as with Claim 44 above, and further in view of *Are You Y2K Complaint* by Anonymous (“Anonymous”).

Claim 57 was rejected under 35 U.S.C. §103(a) as being unpatentable over Rathbone, Jacobs, Rood, and Anonymous, as with Claim 53 above, and further in view of Barzilai.

Claims 58-60 and 62-63 were rejected under 35 U.S.C. §103(a) as being unpatentable over Rathbone, Jacobs, Rood, Kaplan, Siguel and Sparks.

Claim 61 was rejected under 35 U.S.C. §103(a) as being unpatentable over Rathbone, Jacobs, Rood, Kaplan, Siguel, Sparks and Barzilai.

**A. The Cited References Do Not Disclose Each Element of the Claims**

Applicants respectfully traverse and submit that the cited art combinations, even if proper, which Applicants do not concede, do not render the Claimed embodiment of the invention obvious.

In order to establish a *prima facie* case of obviousness, the references cited by the Examiner must disclose all claimed limitations. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974). Furthermore, according to § 2143 of the Manual of Patent Examining Procedure, to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in Applicant’s disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). Finally, the prior art reference (or references when combined) must teach or suggest all the Claim limitations. Furthermore, if any Claim is

nonobvious under 35 U.S.C. § 103, then any Claim depending therefrom is nonobvious. MPEP § 2143.01. Accordingly, if Applicants' independent Claims 44, 53, and 58 are nonobvious, then all remaining Claims, are nonobvious, because they depend from a nonobvious dependent Claim.

**1. The Rathbone-Jacobs-Rood Combination Does Not Teach or Suggest All Limitations of Claim 44**

Even if the Rathbone-Jacobs-Rood combination was proper, which Applicants do not concede, Rathbone-Jacobs-Rood does not teach or suggest each limitation of Applicants' independent Claim 44, from which Claims 45-52 depend. Accordingly, Applicants respectfully submit that a prima facie case of obviousness has not been established for Claims 44-52.

Independent Claim 44, as amended, requires, in part, “**highlighting any components of the old computer system identified by the configuration utility software as differing from the old system configuration data**” and “**altering the old system configuration to reflect any different components identified by the configuration utility software.**” The Examiner has stated that Rood discloses a method comprising “altering (updating) the old system configuration data (PC hardware history) to reflect any different components installed (hardware maintenance).” Office Action at 8. The cited portion of Rood discusses “be[ing] able to list the PC hardware configuration (through a link to the asset tracking system) and be[ing] able to reference the complete past maintenance history on the PC hardware.” See Rood, page 144. The cited portion of Rood neither teaches nor suggests “**highlighting any components of the old computer system identified by the configuration utility software as differing from the old system configuration data**” or “**altering the old system configuration to reflect any different components identified by the configuration utility software,**” as required by independent Claim 44. Rather, the cited portion of Rood discusses “past maintenance history on the PC hardware,” which is not necessarily the same as computer system configuration data or history. Maintenance of PC hardware does not necessarily involve any changes to component installation or configuration. Additionally, when Rood does discuss PC hardware configuration, it is in reference to “be[ing] able to list the PC hardware configuration (through a link to the asset tracking system),” upon which the cited portion of Rood does not elaborate. It is not clear from the cited portion of Rood what information the referenced asset tracking system contains or what

capabilities it has, and additionally, listing a hardware configuration is not the same as altering the configuration. Rood also mentions “referenc[ing] the complete past maintenance history,” but referencing maintenance history is not the same as altering configuration data. Rood does not disclose the altering of any configuration data. Finally, Rood does not mention “highlighting” components, or checking what is different from the output of “configuration utility software” and the “old system configuration,” as required by Claim 44.

Unless each element of the Claim is taught or suggested, an obviousness rejection is improper. Here, because the combination of Rathbone, Jacobs, and Rood does not teach or suggest the elements of Claim 44 listed above, the rejection of Claim 44 should be withdrawn and Claim 44 should be passed to issuance. Each of Claims 45-52 depend from Claim 44, which Applicants have shown to be patentable. Therefore, Applicants request that the rejections of Claim 45-52 be withdrawn and the Claims passed to issuance.

## **2. The Combination of Rathbone, Jacobs, Rood, Kaplan, Siguel and Sparks Do Not Teach or Suggest All Limitations of Claim 58**

Even if Rathbone, Jacobs, Rood, Kaplan, Siguel and Sparks could be combined for the sake of the obviousness rejection asserted by the examiner, the combination of Rathbone, Jacobs, Rood, Kaplan, Siguel and Sparks does not teach or suggest each element of the rejected Claim. Applicants respectfully submit that a prima facie case of obviousness has not been established for Claim 58.

Independent Claim 58 requires, in part, "**computing transaction amounts with and without reuse of the reusable component, the transaction amount equal to the new computer price minus the old computer price; and selecting the lowest transaction amount.**" The examiner states that Siguel disclosed a method comprising "computing transaction amounts (potential savings/costs) with or without use of the reusable part component," and "selecting the most cost-effective option." Office Action at 17. Siguel does not disclose "**computing transaction amounts, ... the transaction amount equal to the new computer price minus the old computer price.**" Additionally, Siguel does not disclose "**selecting the lowest transaction amount.**" The lowest transaction amount (as required by the Claim) is not necessarily the same as the most "cost-effective" option as discussed by Siguel.

Specifically, Siguel states, "The saving due to reusing only your floppy disks, case, and power supply are usually insufficient to justify upgrading the old system." *See* Siguel, page 73. Here, Siguel states that though there may be a **saving** in money by reusing component(s) of the old system, it may not be sufficient to justify a reuse of these components. Siguel is not following the principle of "**selecting the lowest transaction amount**" as the basis of judgment for the decision to reuse components or not. Thus, Siguel does not teach or suggest the element of "**selecting the lowest transaction amount**" from Claim 58.

Unless each element of the Claim is taught or suggested, an obviousness rejection is improper. Here, for the same rationale as applied for passing Claim 44 and because the combination of Rathbone, Jacobs, Rood, Kaplan, Siguel, and Sparks does not teach or suggest the elements of Claim 58 listed above, the rejection of Claim 58 should be withdrawn and Claim 58 should be passed to issuance. Each of Claims 59-63 depend from Claim 58, which Applicants have shown to be patentable. Therefore, Applicants respectfully request that the Examiner withdraw the rejections of Claim 59-63 and pass the Claims to issuance.

**B. There is No Suggestion or Motivation to Modify the Reference or to Combine Reference Teachings**

**1. There is No Suggestion or Motivation to Modify or to Combine Rathbone, Jacobs and Rood to Establish a Prima Facie Case of Obviousness for Claim 44**

Even if the combination of Rathbone, Jacobs, and Rood did teach or suggest each element of the rejected Claims, which Applicants have shown is not the case, there is no suggestion or motivation to modify or to combine Rathbone, Jacobs, and Rood to establish a prima facie case of obviousness for Claim 44.

**a. Modifying Rathbone Not Obvious to One of Ordinary Skill**

The Examiner states that:

It would therefore have been obvious to one of ordinary skill in the art at the time the invention was made that the method utilized by Rathbone would have also utilized the ability to compare configuration data and to determine a compatible component list of

components which may be reused, as is implied by Rathbone and would have been obvious to one of ordinary skill in the art, allowing the user to determine which parts may be reused in a new computer system. (see Office Action, p. 4)

Applicants respectfully submit that it would not have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Rathbone to provide a method comprising the elements of Claim 44. Examiner states that "Comparing configuration data between two systems to access the reusability and/or compatibility of components between one or more systems is old and well-known with the art of computer system design and computer maintenance..." (see Office Action, p. 4) The knowledge of comparing configuration data between two systems alone does not provide the suggestion or motivation to combine this reference with the others provided.

Applicants respectfully submit that the Examiner has not shown that it would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Rathbone to provide a method comprising the above elements, and therefore a prima facie case of obviousness has not been established.

**b. Modifying Rathbone by Incorporating Jacobs Not Obvious to One of Ordinary Skill**

The Examiner states:

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Rathbone by incorporating the ability to request configuration data from the manufacturer's database, as disclosed by Jacobs, to provide an additional avenue through which to secure configuration data of the old computer systems, as well as configuration data of a new computer system, allowing the user to anticipate which components may be reusable. (see Office Action, p. 7)

Applicants respectfully submit that it would not have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Rathbone to provide a method comprising the elements of Claim 44. The examiner does not give any reason why it would have been obvious to one of ordinary skill in the art at the time the invention was made to

have modified Rathbone other than stating that "Searching a manufacturer's database...is old and well known in the art of Internet sales and computer sales..." This knowledge alone is not suggestion or motivation to modify the reference or to combine reference teachings.

Applicants respectfully submit that the Examiner has not shown that it would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Rathbone by incorporating Jacobs to provide a method comprising the above elements, and therefore a prima facie case of obviousness has not been established.

**2. There is No Suggestion or Motivation to Modify or to Combine Rathbone, Jacobs, Rood, and Anonymous to Establish a Prima Facie Case of Obviousness for Claim 53**

Even if the combination of Rathbone, Jacobs, Rood, and Anonymous did teach or suggest each element of the rejected Claims, which Applicants do not cede, there is no suggestion or motivation to modify or to combine Rathbone, Jacobs, Rood, and Anonymous to establish a prima facie case of obviousness for Claim 53. The Examiner states, with respect to Claim 52, that:

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Rathbone, Jacobs and Rood by incorporating a unique tag such as a serial number, as disclosed by Anonymous, to provide a unique identifier to the configuration request, rather than a generic identifier such as a product/model number, as disclosed by Jacobs, to properly and accurately link the configuration request to the user's specific old computer system. (see Office Action, p. 15)

Applicants respectfully disagree that such a combination would have been obvious. The Examiner does not cite any discussion in any of the reference to support why it would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Rathbone, Jacobs, and Rood. Additionally, there is no discussion regarding a suggestion or motivation to combine any of these references with respect to Claim 53. Thus there is no suggestion or motivation to modify the reference or to combine reference teachings, and a prima facie case of obviousness is not established. The rejection of Claim 53 should be withdrawn and Claim 53 should be passed to issuance. Each of Claims 54-57 depend from Claim 53, which

Applicants have shown to be patentable. Therefore, Applicants respectfully request that the Examiner withdraw the rejections of Claim 54-57 and pass the Claims to issuance.

**3. There is No Suggestion or Motivation to Modify or to Combine Rathbone, Jacobs, Rood, Kaplan, Siguel, and Sparks to Establish a Prima Facie Case of Obviousness for Claim 58**

Even if the combination of Rathbone, Jacobs, Rood, Kaplan, Siguel, and Sparks did teach or suggest each element of the rejected Claims, which Applicants have shown is not the case, there is no suggestion or motivation to modify or to combine Rathbone, Jacobs, Rood, Kaplan, Siguel, and Sparks to establish a prima facie case of obviousness for Claim 58. The Examiner states that:

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Rathbone, Jacobs, Rood, Kaplan, Siguel, and Sparks the computation of transaction amounts with and without the reuse of reusable components, as disclosed by Siguel, and selecting the lowest transaction amount to ensure that reusing components from the old computer system was cost-effective, as disclosed by Siguel, as it is fundamental to the practice of reusing components that the reuse of components be cost-effective and that the user of such a method would seek to minimize his/her transaction costs. (see Office Action, p. 18)

Applicants respectfully disagree. Siguel teaches away from the required Claim element of "**selecting the lowest transaction amount.**" As discussed above, Siguel states that savings in cost may not be enough to justify reusing components. In this situation, Siguel does not teach selecting the lowest transaction amount, but actually teaches away from the required Claim element. Thus, a prima facie case of obviousness has not been established.

## CONCLUSION

For the foregoing reasons, Applicants request that Claims 44-63, as amended, be allowed. Early and favorable acceptance of this application is respectfully requested.

Applicants believe no fees are due, however, should any fees be due, the Commissioner is hereby authorized to charge any fees to Deposit Account No. 02-0383 of Baker Botts L.L.P.

Respectfully submitted,

BAKER BOTTS L.L.P.  
Attorney for Applicants

  
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Bradley S. Bowling  
Reg. No. 52,641

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SEND CORRESPONDENCE TO:

BAKER BOTTS L.L.P.  
CUSTOMER ACCOUNT NO. **23640**  
713-229-1802  
713-229-7702 (fax)